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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,758	10/14/2005	M. Dean Savage	F-PRCB-05	1329
26875 7590 02/15/2007 WOOD, HERRON & EVANS, LLP 2700 CAREW TOWER 441 VINE STREET CINCINNATI, OH 45202			EXAMINER MARTIN, PAUL C	
			ART UNIT 1657	PAPER NUMBER
			MAIL DATE 02/15/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/517,758

Applicant(s)

SAVAGE, M. DEAN

Examiner

Paul C. Martin

Art Unit

1657

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 26 January 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: 3, 7, 10, 17 and 22.  
Claim(s) rejected: 1, 2, 4-6, 8, 9, 11-14, 18-21, 23 and 24.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

Continuation of 11.

Claims 14, 18-21, 23 and 24 remain provisionally rejected on the grounds of nonstatutory obviousness-type double patenting over claims 29, 32, 34, 35, 37 and 38 of co-pending Application 10/865893 for reasons of record set forth in the prior Action. Applicant's argument that independent Claim 14 of the instant Application contains a limitation lacking in independent Claim 28 of the '893 Application is not found to be persuasive because the limitation of ascribing a differential fluorescent signal, if any between the fluorescent signal of the sample and the external reference constitutes a mental step and does not materially change the methods of instant Claim 14 and co-pending Claim 28 of the '893 Application. One of skill in the art would have recognized that such a step was the obvious next process when relating an experimental signal to a reference signal.

The rejection of Claims 1-14, 19 and 22-24 under 35 USC 112, 1st paragraph has been withdrawn due to the Applicant's amendments to the claims filed 1/26/07.


Claims 17-21 are newly objected to as being dependent upon canceled Claim 15.

Claims 1, 2, 4-6, 8, 9 and 11-13 stand rejected under 35 USC 102(e) as being anticipated by Nikiforov (US 6,699,655 B2) as evidenced by Cox et al. (US 5,034,189) for reasons of record set forth in the prior Action. The Applicants arguments have been considered but are not found to be persuasive. The Applicant argues that the complex and the fluorophore in the composition must be positioned so that specific quenching will always result whenever the complex forms whereas the Nikiforov composition does not result in specific quenching any time its complex forms (Remarks, Pg. 6, Lines 4-9).

This is not found to be persuasive for the following reasons, the composition of Nikiforov in a solution will at some point be in "proximity" to the fluorophore and to some degree necessarily result in some quenching of the fluorescent label. That the quenching is "specific" or the degree of quenching cannot be determined from the instant claims. Further the composition of Claim 1 is directed toward either a paramagnetic metal ion and an enzyme substrate (anticipated by Nikiforov certainly) OR to the endproduct containing a fluorophore label and a target group to which the paramagnetic metal ion is bound to form a complex, said complex being in proximity to the fluorophore to cause specific quenching of the fluorescence of the label when the complex forms. Therefore, the composition of Nikiforov anticipates the instant composition as claimed.

The rejection of Claims 23 and 24 under 35 USC 103(a) as being obvious over Nikiforov ('141) had been withdrawn due to the Applicant's amendments to the Claims filed 01/26/07.

Claims 14, 23 and 24 are free of the art.

  
**JON WEBER**  
**SUPERVISORY PATENT EXAMINER**